

**REMARKS**

Claims 1 to 68 are pending, and have been restricted under 35 U.S.C. § 121 into the following groups:

Group I (claims 1 to 34), drawn to methods for identifying an effective agent that modulates a biological activity of a nuclear hormone receptor;

Group II (claim 35), drawn to a method for identifying an improved agent that modulates an improved activity of a nuclear hormone receptor; and

Group III (claims 36 to 68), drawn to methods for identifying an effective agent that modulates a protein kinase A activity associated with a nuclear hormone receptor.

The Examiner also alleges that the claims include the patentably distinct species of nuclear hormone receptor set forth in claim 10.

**Election of Invention**

Applicants respectfully traverse the Restriction Requirement for the reasons stated below. Nevertheless, in order to be responsive to the Office Action, Applicants provisionally elect the invention of Group I (claims 1 to 34) and further provisionally elect the retinoid X receptor (RXR) species of nuclear hormone receptor. Each of the claims of Group I read, at least in part, upon the elected RXR species.

Traversal

Applicants respectfully traverse the restriction of the claim of Group II (claim 35) from the claims of Group I (claims 1 to 34) and respectfully point out that two separate requirements must be met in order for restriction to be proper. First, the inventions must be independent or distinct. Secondly, there must be a serious burden on the Examiner if restriction is required. See, for example, MPEP 803 (Restriction- When Proper), which states, in part:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Page 800-3; emphasis added.

Thus, it is not sufficient for an Examiner to assert that patentably distinct inventions are present in order to issue a Restriction Requirement or require an election of species. There also must be a serious burden on the Examiner to search and examine the entire application.

In the present case, the single claim of Group II contains the four method steps (a, b, c and d) of the Group I claims (compare, for example, claim 1 and claim 35) and further recites an additional step of assaying for direct transcriptional activity of the nuclear hormone receptor. Given the extensive overlap between the methods, Applicants submit

that the Examiner would not be seriously burdened to search and examine the Group II claim (claim 35) with the claims of Group I.

Applicants further respectfully traverse the restriction of the claims of Group III (claims 36 to 68) from the claims of Group I. While the two groups are patentably distinct, the claims of Group III are related to the claims of Group I in that they are directed to methods for identifying an effective agent that modulates a particular biological activity of a nuclear hormone receptor, specifically, protein kinase A activity associated with a nuclear hormone receptor. Thus, a thorough search of the claims of Group I would yield art relevant to the claims of Group III, and there would be little additional work for the Examiner to search and examine the claims of Group III (claims 35 to 68) with the claims of Group I (claims 1 to 34). Because there would not be a "serious burden" on the Examiner to search and examine the claims of Groups I and III together, Applicants submit that restriction of these two groups is not proper. The Examiner is respectfully requested to rejoin the claims of Group III with the claims of Group I.

Regarding the Election of Species requirement, Applicants respectfully remind the Examiner that subject matter directed to non-elected species previously withdrawn from consideration must be rejoined and examined for patentability if a linking claim such as generic claim 1 is found allowable (MPEP 809).

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**CONCLUSION**

In view of the above remarks, Applicants elect the claims of Group I and the species RXR and respectfully request that the Examiner reconsider the restriction requirement and examine the claims of Groups II and III together with those of elected Group I. Should the Examiner have any questions, he is invited to call the undersigned agent or Cathryn Campbell.

Respectfully submitted,

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